

R E M A R K S

Claims 1-11 and 13-32 are currently pending in the present application. In the instant Office Action, the Examiner raised a number of issues which are set forth by number in the order they are herein addressed:

- 1) Claim 11 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1, 13, 18, and 19 of copending Appln. No. 09/755,644;
- 2) Claims 3-6, 11, 29, 31, and 32 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite; and
- 3) Claims 1-28 and 30 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Pungs (U.S. Patent No. 1,950,814), in view of Egan (U.S. Patent No. 1,935,946).

Applicants hereby add new Claims 12, 33, and 34, amend Claims 2-6, 9, 11, 16, 22, 24, and 29, and cancel Claims 30-32, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) There Is No Double Patenting

The Examiner has provisionally rejected Claim 11 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1, 13, 18, and 19 of copending Patent Appln. No. 09/755,644. Applicants must respectfully disagree. However, in order to further their business interests and the prosecution of the present application, but without acquiescing to the Examiner's arguments, Applicants herewith file a Terminal Disclaimer (Tab 1) to overcome any obviousness type double patenting rejections.

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000).

2) The Claims Are Definite

The Examiner has rejected Claims 3-6, 11, 29, 31, and 32 under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention.

In the first place, the Examiner indicates that Claims 3-6 should read "have" instead of "having." Applicants thank the Examiner for pointing out this clerical error and have amended Claims 3-6 to read "have."

In the second place, the Examiner indicates that "[i]n claim 11, it is not clear if the fatty material may be any one of the materials or all of the materials. Clarification and/or correction are required" (Office Action, page 3). Applicants have amended Claim 11 to read "wherein said fatty material comprises one or more of triglycerides, free fatty acids, and fatty alcohols." Applicants note that a Claim 12 was inadvertently omitted from the claim set as originally filed. For this reason, a new Claim 12 is added herein, which includes the recitation "wherein said fatty material comprises two or more of triglycerides, free fatty acids, and fatty alcohols." Support for these amendments is found in Tables I-VI of the Specification.

Thirdly, the Examiner indicates that "[i]n claims 31-32, it is not clear if the fatty acids are those of claim 18 and if not what percentage of hydrogenated fatty acids are present in the composition" (Office Action, page 3). Applicants respectfully disagree. Nonetheless, Applicants have canceled dependent Claims 31 and 32, and have rewritten these claims as new independent Claims 33 and 34, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s). New Claims 33 and 34 do not specifically limit the fatty acid component to hydrogenated fatty acids.

Lastly, the Examiner indicates that "[i]n claim 29, it is not clear how the candle is comprised of 100% alcohol. Clarification is required" (Office Action, page 3). Applicants respectfully disagree. Nonetheless, Applicants have amended Claim 29, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s). In particular,

Applicants have amended Claim 29 to recite "less up to 5% by weight impurities in said fatty alcohols." Support for this amendment can be found in Table VI of the instant application, which teaches candle compositions comprising approximately 100% fatty alcohols and that the fatty alcohol "shown above is [a] percentage by weight of Fatty Alcohol ... of 95% or greater purity" (Specification, page 19, at lines 22 - 24).

3) The Claims Are Patentable Over Pungs In View of Egan

The Examiner has rejected Claims 1-28 and 30 under 35 U.S.C. §103(a), as allegedly unpatentable over Pungs (U.S. Patent No. 1,950,814) in view of Egan (U.S. Patent No. 1,935,946) stating:

Pungs teaches a candle composition comprising free fatty alcohols that are prepared from montan waxes or vegetables. The alcohols have 14 or more carbon atoms and a melting point of above 45°C. The alcohol is present in the candle composition in an amount from 1.5 to 20% (see lines 1-54). The candle base material may be paraffin wax, stearine, stearic acid or synthetic fatty acids (see lines 55-68). Pungs teaches that the candles have non-smoky flames (see lines 84-88). Pungs teaches the limitations of the claims other than the differences that are discussed below.

Pungs fails to teach the claimed IV; however, it would have been obvious to one of ordinary skill in the art to have prepared the composition possessing the claimed IV because Pungs teaches saturated fatty alcohols in combination with paraffin wax and/or stearic acid or stearine (saturated compounds).

Pungs differs from the claims in that he does not teach hydrogenated free fatty acids. However, Egan teaches this difference.

Egan teaches a candle composition wherein natural oils are hydrogenated to an IV of 5 or lower and separates the fatty acid from the oil (see lines 1-15, 33-54).

It would have been obvious to one of ordinary skill in the art to have substituted hydrogenated stearic acid for stearic acid because Egan teaches that hydrogenated stearic acid allows the candle maker to use less refined paraffin wax (see lines 28-41).

Applicants respectfully disagree. Nonetheless, Applicants have amended Claims 2, 9, 16, and 24, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s). In particular, Applicants have amended Claims 2 and 24 to recite "wherein said fatty alcohol(s) comprise at least 25% by weight of said candle/composition." Support for this amendment can be found in candle compositions 5-16 of Table V, comprising 25% to 50% by weight of fatty alcohol. Further support can be found in Table VI, which teaches

candle compositions comprising approximately 100% by weight of one or more C12-C18 fatty alcohols. Additionally, Applicants have amended Claims 9 and 16 to recite "including at least 1% by weight paraffin to 70% by weight paraffin." Support for this amendment can be found in the text of original Claim 32 and in candle compositions 1-9 of Table IV, comprising 1% to 70% paraffin.

The Examiner is reminded that a *prima facie* case of obviousness requires (a) some suggestion or motivation (in either the references themselves or in the knowledge of one of ordinary skill in the art) to combine the reference teachings, (b) a reasonable expectation of success, and (c) a teaching or suggestion of all claim limitations (MPEP, 2143). Applicants respectfully submit the Examiner has failed to establish each of the three elements of a *prima facie* case of obviousness. In addressing this rejection, Applicants largely focus on independent Claims 1, 11, 18, and 24, since non-obviousness of an independent claim necessarily leads to non-obviousness of claims dependent therefrom. Applicants respectfully point out that the claimed invention is directed to candles or candle compositions with specific Iodine Value limitations (*e.g.*, Claims 1, 11, and 18) or specific melting point and fatty alcohol content limitations (*e.g.*, currently amended Claim 24).

(a) No Suggestion or Motivation to Combine the References

The Examiner is also reminded that the mere fact that the references can be combined does not render the resultant modification obvious, unless the prior art also suggests the desirability of the modification.² Pungs is essentially concerned with the preparation of opaque candles which are free of cracks and less liable to breakage (*See*, lines 77-84). In contrast, Egan is essentially concerned with the production of candles from cheaper, less-refined paraffin (*See*, lines 28-35). Applicants assert that since Pungs and Egan were directed at solving distinct problems, the requisite motivation to combine the references is lacking.

That said, even if the Examiner's argument of combining Pungs and Egan in order to permit a candle maker to use less refined paraffin wax was valid, embodiments lacking paraffin could not reasonably be suggested. In particular, under no circumstances could Claims 10, 18-25, 29, and 33, lacking the paraffin recitation, be found to be obvious in view

² *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

of a motivation to combine references based solely upon the Examiner's proposed desire to use unrefined paraffin wax.

(b) No Reasonable Expectation of Success

Applicants submit that the Examiner has simply set forth an argument that it would be "obvious to try" to develop the presently claimed invention. However, this is a standard which has been thoroughly discredited. "Indeed, an obviousness rejection is inappropriate, where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful."³ As indicated above, the Examiner admitted that Pungs does not teach compositions comprising the claimed IV range, while Egan simply teaches compositions comprising a fatty acid derived from a hydrogenated oil with an IV of 5 or lower. Thus, even if combined, the teachings of Pungs and Egan could not be expected to yield a candle composition in which the **total fatty material** (*e.g.*, not simply the free fatty acid component) has an **Iodine Value of approximately 12.5 or less**.

Applicants respectfully remind the Examiner that "IVs are an indication of the degree of unsaturation within the fatty alcohols, triglycerides and/or free fatty acids, and the amount of unsaturated fatty alcohols, triglycerides and/or fatty acids is proportional to the amount of undesired combustion products (Specification, page 5, at lines 25-28). Saturation of a fatty material (*e.g.*, triglycerides, free fatty acids, and/or fatty alcohols) is a matter of degrees, as opposed to a fully saturated/fully unsaturated toggle. Thus, mixtures of the same basic ingredients differing in the level of processing of the fatty material will yield varying IV values as shown in Table 1 (Specification, page 8). In particular, Table I demonstrates that candles comprised of paraffin, triglycerides and free fatty acids can yield IV values beyond that of the claimed invention (*e.g.*, IV ~14).

Additionally, Applicants disclosed that "[l]ower IVs are typically achieved with increased substrate processing time and costs (*i.e.*, more comprehensive hydrogenation processing). Thus, a candle with IV of 14-10 may have a cost that is less than that of a candle having an IV of 7.5 or 5 or less" (Specification, page 23, at lines 12-15). For this

³ Quoting *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 [Fed. Cir. 1988], *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 10 USPQ2d 1843, 1845 [Fed. Cir. 1989].

reason, skilled artisans attempting to produce inexpensive candles would be unlikely to develop a candle in which the fatty material has the claimed low IV (**12.5 or less**).

(c) All Claim Limitations are neither Taught nor Suggested

The Examiner is also reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."⁴ As discussed above, Claims 1, 11, and 18, require that the **total fatty material** (*e.g.*, not simply the free fatty acid component) have an **Iodine Value of approximately 12.5 or less**. In addition, newly amended Claim 24 requires that the **fatty alcohols** comprise at least **25% by weight** of said composition.

In fact, the primary reference (Pungs) discloses that the fatty alcohol component of the candle composition should be between 1.5 and 20 per cent, and teaches candle compositions consisting of from 2 to 18 per cent fatty alcohol (*See*, lines 3-11 and Table 1). This is in contrast to the claimed invention which in some embodiments includes the limitation that "said fatty alcohol comprises at least 25% by weight of said candle/composition" (*e.g.*, Claims 2, and 24-30).

Moreover, Pungs teaches candle compositions comprising 82 to 100% paraffin (*See*, Table 1), while Egan discloses candle compositions comprising 90 to 95% paraffin (*See*, Claim 4). This is in contrast to the claimed invention which in some embodiments requires "paraffin in an amount from about 1% by weight to about 70% by weight" (*e.g.*, Claims 9, 16, and 34), and in other embodiments either specifically excludes or does not require paraffin (*e.g.*, Claims 10, 18-25, 29, and 33).

As a *prima facie* case of obviousness has not been established, Applicants respectfully request that this rejection be withdrawn.

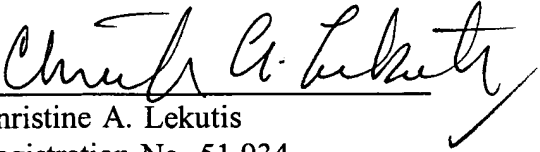
CONCLUSION

Applicants believe that the amendments and arguments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn.

⁴ *See, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourages the Examiner to call the undersigned collect.

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